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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER HASHEM, LISA	
			ART UNIT 2614	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/089,681	Applicant(s) RATSCHUNAS ET AL.	
	Examiner Lisa Hashem	Art Unit 2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8-12, 14-17, 20-23, 35 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-12, 14-17, 20-23, 35, and 37-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see RCE, filed 8-15-07, with respect to the rejection(s) of claim(s) 1-5, 8-12, 14-17, 20-23, 35, and 37-41 have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejection(s) below.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 8, 9, 11, 12, 14-17, 20, 21, 35, 37, 40, and 41 are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,101,393 by Alperovich.

Regarding claim 1, Alperovich discloses a method comprising:

delivering messages in a network comprising at least one terminal device (i.e. target MS; Fig. 2, 22),

wherein delivering messages comprises:

generating a message (col. 4, lines 10-14);

setting a condition for receiving said message (i.e. acceptance/rejection based on origin identifier, delivery delay time has expired) (col. 4, lines 14-20);

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deciding whether said message is to be received by a terminal device on the basis of said condition (col. 4, lines 57-62; col. 4, lines 28-47);  
transmitting said message to said terminal device on the basis of a result of the deciding whether the message is to be received (col. 4, lines 57-62; col. 4, lines 28-56),  
deciding whether an originator of said message is allowed to receive a delivery report by referring to a list of originators of messages (i.e. rejection list) which are allowed to receive delivery reports (i.e. this occurs when said message is rejected and is not transmitted to said terminal device on the basis of a result of the screening mechanism),  
and transmitting said delivery report to the originator of said message only in case said originator of said message is on said list of originators (i.e. rejection list) (col. 6, lines 22-50).

Regarding claim 2, the method according to claim 1, wherein Alperovich further discloses the condition is set by a terminal device (col. 4, lines 28-62; col. 5, line 51 –col. 6, line 6).

Regarding claim 3, the method according to claim 1, wherein Alperovich further discloses said condition is a location of said terminal device (col. 4, lines 28-62).

Regarding claim 4, the method according to claim 1, wherein Alperovich further discloses including information regarding said condition in an optional field of said message (col. 4, lines 28-42; col. 5, lines 31-48).

Regarding claim 5, the method according to claim 1, wherein Alperovich further discloses determining whether said terminal device is inactive or busy when said condition is not met (col. 4, lines 57-62).

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Regarding claim 8, the method according to claim 1, wherein Alperovich further discloses defining a group of users (i.e. originators on rejection list) which are allowed to receive delivery reports, wherein in said deciding whether said message is to be received it is detected whether the originator of said received message is a member of said group of users (col. 4, lines 28-47; col. 5, lines 22-50).

Regarding claim 9, the method according to claim 8, wherein Alperovich further discloses adding a group identifier identifying said group of users to said message (col. 5, line 51 – col. 6, line 21).

Regarding claim 11, the method according to claim 1, wherein Alperovich further discloses said network is a mobile network (Fig. 2) and said terminal device is a mobile terminal device (Fig. 2, 22) (col. 3, lines 14-36).

Regarding claim 12, Alperovich discloses a network system (Fig. 2) configured to deliver messages in a network (i.e. PLMN), comprising:  
a message delivering device (i.e. SC; Fig. 4, 35); and  
a terminal device (i.e. GMSC; Figs. 2 and 4: 40);  
wherein said message delivering device comprises a deciding unit configured to decide whether a message is to be received by said terminal device on the basis of a condition (i.e. acceptance/rejection based on origin identifier, delivery delay time has expired) for receiving said message, and a transmitting unit configured to transmit said message to said terminal device on the basis of a deciding result of said deciding unit to said terminal device (col. 4, lines 10-22), wherein said terminal device further comprises a judging unit (i.e. screening mechanism)

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configured to determine whether a delivery report is to be transmitted or not in response to receiving said message;

a transmitting unit configured to transmit said delivery report in case said judging means judges that said delivery report is to be transmitted, and

a database (i.e. HLR; Fig. 4) in which a list of originators of message is stored (i.e. rejection list) which are allowed to receive delivery reports and which is accessed by said judging means (i.e. this occurs when said message is rejected and is not transmitted to said terminal device on the basis of a result of the screening mechanism) (col. 5, lines 6-50).

Regarding claim 14, the system of claim 12, wherein Alperovich further discloses a setting unit configured to set a condition for receiving a message by said terminal device (col. 4, lines 28-62; col. 5, line 51 –col. 6, line 6).

Regarding claim 15, the system according to claim 12, wherein Alperovich further discloses said condition is the location of said terminal device (col. 4, lines 28-62).

Regarding claim 16, the system according to claim 12, wherein Alperovich further discloses said message comprises an optional field in which information regarding said condition is included (col. 4, lines 28-42; col. 5, lines 31-48).

Regarding claim 17, the system according to claim 12, wherein Alperovich further discloses said message delivering device further comprises a determining unit configured to determine said terminal device as not being reachable in case said deciding means decides that said condition is not met (col. 4, lines 28-62).

Regarding claim 20, the system according to claim 12, wherein Alperovich further discloses a group of users (i.e. originators on rejection list) are defined which are allowed to

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receive delivery reports, and said judging unit is configured to detect whether the originator of said received message is a member of said group of users (col. 4, lines 28-47; col. 5, lines 22-50).

Regarding claim 21, the system of claim 20, wherein Alperovich further discloses a group identifier identifying said group of users is added to said message (col. 5, line 51 – col. 6, line 21).

Regarding claim 35, Alperovich discloses a terminal device (i.e. GMSC; Figs. 2 and 4; 40) configured to receive a message for which a condition (i.e. acceptance/rejection based on origin identifier, delivery delay time has expired) for receiving said message is set for use in network (i.e. PLMN), comprising:

a receiving unit configured to receive said message (col. 4, lines 22-27);

a judging unit (i.e. screening mechanism) configured to judge whether a delivery report is to be transmitted or not in response to receiving said message by referring to a database (i.e. HLR) in which a list of originators of messages is stored (i.e. rejection list) which are allowed to receive delivery reports; and

a transmitting unit configured to transmit said delivery report in case said judging unit judges that the originator of said message is on said list of originators (i.e. this occurs when said message is rejected and is not transmitted to said terminal device on the basis of a result of the screening mechanism) (col. 5, lines 6-50).

Regarding claim 37, the terminal device of claim 35, wherein Alperovich further discloses said condition is a location of said terminal device (col. 4, lines 28-62).

Regarding claim 40, Alperovich discloses a network system (Fig. 2) configured to deliver messages in a network (i.e. PLMN), comprising:

a message delivering device; and

a terminal device (i.e. GMSC; Figs. 2 and 4, 40); wherein

said message delivering device (i.e. SC; Fig. 2, 35) comprises means for deciding whether a message is to be received by said terminal device on the basis of a condition (i.e.

acceptance/rejection based on origin identifier, delivery delay time has expired) for receiving

said message, and means for transmitting said message on the basis of a deciding result of said

means for deciding said terminal device (col. 4, lines 14-22),

wherein said terminal device further comprises means for judging whether a delivery report is to be transmitted or not in response to receiving said message (col. 4, lines 28-47);

means for storing a list of originators of messages (i.e. rejection list) which are allowed to receive delivery reports and which is accessed by said means for judging; and

means for transmitting said delivery report in case said means for judging judges that said delivery report is to be transmitted (i.e. this occurs when said message is rejected and is not

transmitted to said terminal device on the basis of a result of the screening mechanism) (col. 5, lines 6-50).

Regarding claim 41, Alperovich discloses a terminal device (i.e. GMSC; Figs: 2 and 4, element 40) for receiving a message for which a condition for receiving said message is set for use in network (Fig. 2), comprising means for receiving said message;

means for judging (i.e. screening mechanism) whether a delivery report is to be transmitted or not in response to receiving said message (col. 4, lines 7-47);



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means for storing a list (i.e. rejection list) of originators of messages (Fig. 4) which are allowed to receive delivery reports and which is accessed by said means for judging; and  
means for transmitting said delivery report in case said judging means judges that said delivery report is to be transmitted (i.e. this occurs when said message is rejected and is not transmitted to said terminal device on the basis of a result of the screening mechanism) (col. 5, lines 6-50).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 22, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich, as applied to claims 1, 12, and 35, respectively, in further view of Gleason.

Regarding claim 10, the method of claim 1, wherein Alperovich does not disclose said message is a multimedia message.

Gleason discloses a method comprising: a terminal device (Fig. 1, 10) for receiving a message for which a condition for receiving said message is set for use (col. 10, lines 46-55; col. 12, lines 2-7; col. 24, line 66 – col. 25, line 2) in network (Fig. 1), a method comprising: receiving said message (col. 10, line 46 – col. 11, line 10);  
determining whether a delivery report is to be transmitted in response to receiving said message;  
and  
transmitting said delivery report when said judging means determines that said delivery report is to be transmitted (col. 12, lines 46-57; col. 20, lines 44-53; col. 25, lines 16-26).

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Wherein Gleason said message is a multimedia message (e.g. a MM can contain all kind of messages, like sounds, speech, etc.) (col. 10, lines 28-30; col. 12, lines 4-7; col. 37, lines 54-57).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include said message is a multimedia message as taught by Gleason. One of ordinary skill in the art would have been lead to make such a modification in order to deliver a variety of messages including pictures, video clips, sounds, speech, etc.

Regarding claim 22, the system according to claim 12, wherein Alperovich does not disclose said message is a multimedia message.

Gleason discloses a system comprising: a terminal device (Fig. 1, 10) for receiving a message for which a condition for receiving said message is set for use (col. 10, lines 46-55; col. 12, lines 2-7; col. 24, line 66 – col. 25, line 2) in network (Fig. 1), a system comprising: receiving said message (col. 10, line 46 – col. 11, line 10); determining whether a delivery report is to be transmitted in response to receiving said message; and transmitting said delivery report when said judging means determines that said delivery report is to be transmitted (col. 12, lines 46-57; col. 20, lines 44-53; col. 25, lines 16-26).

Wherein Gleason said message is a multimedia message (e.g. a MM can contain all kind of messages, like sounds, speech, etc.) (col. 10, lines 28-30; col. 12, lines 4-7; col. 37, lines 54-57).

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It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Alperovich to include said message is a multimedia message as taught by Gleason. One of ordinary skill in the art would have been lead to make such a modification in order to deliver a variety of messages including pictures, video clips, sounds, speech, etc.

Regarding claim 38, the terminal device of claim 35, wherein Alperovich does not disclose said message is a multimedia message.

Gleason discloses a terminal device (Fig. 1, 10) for receiving a message for which a condition for receiving said message is set for use (col. 10, lines 46-55; col. 12, lines 2-7; col. 24, line 66 – col. 25, line 2) in network (Fig. 1), comprising:

a receiving means configured to receive said message (col. 10, line 46 – col. 11, line 10);

a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message;

and a transmitting means configured to transmit said delivery report when said judging means determines that said delivery report is to be transmitted (col. 12, lines 46-57; col. 20, lines 44-53; col. 25, lines 16-26).

Wherein Gleason said message is a multimedia message (e.g. a MM can contain all kind of messages, like sounds, speech, etc.) (col. 10, lines 28-30; col. 12, lines 4-7; col. 37, lines 54-57).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the terminal device of Alperovich to include said message is a multimedia message as taught by Gleason. One of ordinary skill in the art would have been lead to make

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such a modification in order to deliver a variety of messages including pictures, video clips, sounds, speech, etc.

6. Claims 23 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich, as applied to claims 12 and 35, respectively, in further view of Mukherjee.

Regarding claim 23, the system of claim 12, wherein Alperovich further discloses said network is a mobile network (i.e. PLMN; Fig. 2) (col. 3, lines 14-36).

However, Alperovich does not disclose said terminal device is a mobile terminal device.

Mukherjee discloses a network system configured to deliver messages in a network (Fig.

1), comprising:

a message delivering device; and a terminal device (e.g. a service center; Fig. 1, 18; Fig. 4, 170); wherein said message delivering device comprises a deciding unit configured to decide whether a message is to be received by said terminal device on the basis of a condition (e.g. if the originator is allowed to send a SMS message to a receiving subscriber or receiving group of subscribers) for receiving said message (col. 4, lines 7-37; col. 6, lines 21-30), and a transmitting unit configured to transmit said message to said terminal device on the basis of a deciding result of said deciding unit to said terminal device (col. 6, lines 21-30), wherein said terminal device further comprises (e.g. a service center; Fig. 1, 18; Fig. 4, 170)

a judging unit configured to determine whether a delivery report is to be transmitted or not (col. 3, lines 15-26; col. 4, lines 17-37; col. 6, lines 13-30; e.g. delivering a report to an authorized originator when said message is sent to a recipient);

a transmitting unit configured to transmit said delivery report in case said judging means judges that said delivery report is to be transmitted (col. 6, lines 21-30), and

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a database (e.g. multipoint usergroup database; Fig. 2, 26) in which a list of originators of message is stored (e.g. specified originator list) (Fig. 2) which are allowed to receive delivery reports and which is accessed by said judging means (col. 4, lines 7-58; col. 5, lines 6-21; col. 5, line 66 – col. 6, line 30).

Wherein Mukherjee further discloses said network is a mobile network (Fig. 1) and said terminal device is a mobile terminal device (Fig. 1, 12) (col. 3, lines 3-33).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Alperovich to include said terminal device is a mobile terminal device as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification in order to receive a message at a personal user device such as a mobile terminal in order for the recipient to view the message instantly.

Regarding claim 39, the terminal device of claim 35, wherein Alperovich further discloses said network is a mobile network (i.e. PLMN; Fig. 2) (col. 3, lines 14-36).

Mukherjee discloses a terminal device (e.g. a service center; Fig. 1, 18; Fig. 4, 170) configured to receive a message for which a condition (col. 3, lines 15-21; col. 4, lines 7-44) for receiving said message is set for use in network (Fig. 1; Fig. 4), comprising: a receiving unit configured to receive said message (col. 4, lines 59-66; col. 5, lines 37-43); a judging unit configured to judge whether a delivery report is to be transmitted or not (e.g. delivering a report to an authorized originator when said message is sent to a recipient); and a transmitting unit configured to transmit said delivery report in case said judging means judges that said delivery report is to be transmitted (col. 6, lines 21-30);

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a database (e.g. multipoint usergroup database; Fig. 2, 26) in which a list of originators is stored (Fig. 2, 26), which are allowed to receive delivery reports, and which is accessed by said judging means (col. 4, lines 7-58; col. 5, lines 6-21; col. 5, line 66 – col. 6, line 30).

Wherein Mukherjee further discloses said network is a mobile network (Fig. 1; Fig. 4) and said terminal device is a mobile terminal device (e.g. device connected to a mobile network) (Fig. 1, 18; Fig. 4, 170) (col. 3, lines 3-33; col. 5, lines 37-65; col. 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the terminal device of Alperovich to be a mobile terminal device as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification in order to receive a message at a personal user device such as a mobile terminal in order for the recipient to view the message instantly.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

8. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh

August 17, 2007



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